

REMARKS/ARGUMENTS

Status of Application

Original claims 1-16 remain in this application. In view of the above amendments and the following remarks, reconsideration of the application is respectfully requested.

Support For Amended Claims

It is respectfully submitted that the amended claims are supported by the application, that the amended claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in *haec verba* in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

Discussion

Claims 1-8

Independent claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,737,539 to Edelson et al. The amendments to claim 1 were not made to overcome prior art, but to make the claims more clear with respect the nature of the system for accessing pharmacy data and ordering prescriptions via a network. It is respectfully submitted that the invention recited in claim 1 was not anticipated by Edelson et al. Amended claim 1 is set forth below:

Claim 1 A system for accessing pharmacy data and ordering prescriptions via a network comprising:
a network server connected to the network that is accessible by one or more customers via the network;
an application server connected to the network server;
a database connected to the application server, the database containing information concerning drugs and personal information concerning one or more of the customers; and
an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities, the intranet server being connected to the application server;
wherein the application server is configured to allow each of the one or more customers to access the information concerning drugs and personal information concerning each respective customer of the one or more customers and enable each of the one or more customers to one of transmit a prescription order to at least one of the plurality of member pharmacies and one of the one or more shipping facilities.

As should be apparent from the underlined and bolded portions of independent claim 1 set forth above, claim 1 is directed to a system for customers to access pharmacy data and order prescriptions via a network that includes an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities. The system also includes an application server that is configured to allow customers to access the information concerning drugs and personal information concerning each respective customer and to enable the customers to transmit a prescription order to at least one of the plurality of member pharmacies and one of the one or more shipping facilities.

Edelson et al. generally discloses a professional data management system, and in particular, a computer-implemented prescription management system to assist physicians in prescribing and reviewing drugs. It is respectfully submitted that the Edelson et al. does not appear to disclose: (1) an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities; and (2) an application server that is configured to allow each of the one or more customers to access the information concerning drugs and personal information concerning each respective customer of the one or more customers and enable each of the one or more customers to one of transmit a prescription order to at least one of the member pharmacies and one of the shipping facilities (i.e. one of the shipping facilities connected to the intranet server).

Column 38 lines 36-40 of Edelson et al. is cited in the Office Action as disclosing the above elements. However, there is no disclosure in that section of Edelson et al. of connecting the system's intranet server to a shipping facility which enables a customer to transmit a prescription order to the shipping facility. Nor does there appear to be such disclosure anywhere in Edelson et al. Column 38 lines 36-40 of Edelson et al. merely disclose that a number of printed "reports can be enhanced to provide entirely new products for example ... and shipping schedules or split prescriptions divided according to suppliers requirements."

Since no embodiment of Edelson et al. appears to disclose the invention recited in claim 1, it is submitted that claim 1 was not anticipated by Edelson et al.¹ In order for a claim to be anticipated under § 102, the anticipating reference must disclose at least one embodiment that incorporates all of the claimed elements. See for example, C.R. Bard, Inc. v. M3 Systems, 48 U.S.P.Q.2d 1225, 1230 (Fed. Cir. 1998) ("When the defense of lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device..."); In re Bond, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) ("For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference... These elements must be arranged as in the claim under review...").

Furthermore, the system for accessing pharmacy data and ordering prescriptions via the network as recited in amended claim 1 includes (1) a network server that is accessible by one or more customers, (2) a database that contains information concerning drugs and personal information concerning one or more of the customers, and (3) an application server that is configured to allow each of the one or more customers to access the information concerning drugs and personal information concerning each respective customer of the one or more customers and enable each of the one or more customers to one of transmit a prescription order to at least one of the plurality of member pharmacies and one of the one or more shipping facilities. It is submitted that Edelson et al. appears to only disclose allowing access to the system by physicians and "other medical professionals, especially those having

¹ If the Examiner believes there is an embodiment in Edelson et al. that incorporates all of the recitations of one of the claims, he is respectfully invited to point it out and explain how it includes all the recitations of the claim.

prescribing authority." (Col. 51, ll 41-42) In fact, Edelson et al. distinguishes between customers and professionals by the following: "[i]n a more general sense, the invention provides a service professional with significant new benefits, especially during a service encounter with a customer or client, in selecting, specifying or providing technical remedies to consumer problems." (Col. 51, ll 44-47; *see also* Col 5, l 66 to Col. 6, l 8 and Col. 52, ll 18-29) Nowhere in Edelson et al. does it appear to disclose allowing the actual customer to (1) access a network server, (2) access a database containing information concerning drugs and personal information of the customer, and (3) access an application server containing information concerning drugs and personal information concerning the customer and enable the customer to one of transmit a prescription order to a member pharmacy and a shipping facility.

Therefore, the invention recited in independent claim 1 is not anticipated by Edelson et al. It is respectfully submitted that claim 1 and claims 2-8 which depend therefrom are allowable over the applied patent.

Claims 9-16

Independent claim 9 was also rejected under 35 U.S.C. §102(b) as being anticipated by Edelson et al. It is respectfully submitted that the invention recited in claim 9 was not anticipated by Edelson et al. Amended claim 9 is set forth below:

Claim 9 A method enabling one or more customers to order prescriptions and access pharmacy data via a network comprising the steps of:
 accessing a network server hosting a network website via the network;
 registering a customer with the network website;
 displaying to the customer on the website at least one of a prescription order selection and a pharmacy data access selection;
 displaying one or more prescription order displays to the customer on the website when the customer selects the prescription order selection wherein the customer is allowed to select to transmit a particular prescription order to a communication network that connects at least one of a plurality of member pharmacies and one or more distribution facilities; and

displaying one or more pharmacy data access displays to the customer when the customer selects the pharmacy data access selection wherein the customer is allowed to access one of a personal prescription history and specific drug information from a database.

As should be apparent from the underlined and bolded portions of independent claim 9 set forth above, claim 9 is directed to a method of enabling one or more customers to order prescriptions and access pharmacy data via a network that includes registering a customer with a network website and displaying to the customer on the website at least one of a prescription order selection and a pharmacy data access selection. The method also includes displaying one or more prescription order displays to the customer on the website when the customer selects the prescription order selection wherein the customer is allowed to select to transmit a particular prescription order to a communication network that connects at least one of a plurality of member pharmacies and one or more distribution facilities, and displaying one or more pharmacy data access displays to the customer when the customer selects the pharmacy data access selection wherein the customer is allowed to access one of a personal prescription history and specific drug information from a database.

As noted in connection with claim 1, there does not appear to be any disclosure in Edelson et al. of (1) enabling one or more customers to order prescriptions and access pharmacy data via a network, (2) registering a customer with the network website, (3) displaying to the customer one of a prescription order selection and a pharmacy data access selection, (4) displaying one or more prescription order displays to the customer on the website when the customer selects the prescription order selection wherein the customer is allowed to select to transmit a particular prescription order to a communication network that connects at least one of a plurality of member pharmacies and one or more **distribution facilities**; and (5) displaying one or more pharmacy data access displays to the customer.

Accordingly, it is submitted that claim 9, and claims 10 - 16 which depend therefrom, are not anticipated by Edelson et al.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is

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respectfully requested to pass this application to issue. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

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Respectfully submitted,

By 

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